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July 29, 2004

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant(s): Virginia Goss Tusher

Title: Significance Analysis of Microarrays

Application No.: 09/811,762

Filing Date: March 19, 2001

Examiner: Ardin H. Marschel

Group Art Unit: 1631

Docket No.: STAN.058US1

Conf. No.: 8102

Dear Sir:

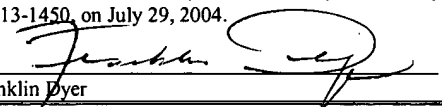
Transmitted herewith are the following documents in the above-identified application:

- (1) Return Receipt Postcard;
- (2) This Transmittal Letter (1 page);
- (3) Response to Office Action (2 pages);

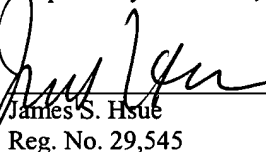
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Franklin Dyer

Respectfully submitted,


James S. Hsue
Reg. No. 29,545

7/29/04
Date



THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Signature 

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Dear Sir:

This is in response to the Office communication mailed on June 29, 2004 setting a period for a response expiring on July 29, 2004. This response supercedes and replaces the responses signed by the undersigned and mailed on March 29, 2004 and November 12, 2003, which responses were deemed by the examiner to be non-responsive, and which responses, we believe, have not been entered. Therefore, the status of the claims is that no claims have been cancelled, and that the claims pending are claims 1-64.

We appreciate the telephone interview granted by the examiner Mr. Marschel on July 27, 2004 concerning the status of the application. The Office communication mailed on June 29, 2004 was discussed as to the reason why the responses of March 29, 2004 and November 12, 2003, were deemed by the examiner to be non-responsive. The examiner indicated that since the rules for claim cancellation were not complied with in the response of November 12, 2003, it is not clear what claims are pending in the application. The response of November 12, 2003 is thus non-responsive. The response of March 29, 2004 did not indicate whether it supercedes the prior response of November 12, 2003, so that it is still not clear what claims are pending in the

application. According to the examiner, to be responsive, the response filed should clarify which claims are presently pending in the application.

The undersigned attorney appreciates the telephonic interview granted by the Examiner, Mr. Marschel on November 12, 2003. During the interview, the undersigned attorney proposed that the restriction requirement be modified in order to combine sets I and II into a single group, on the ground that the combination would not require separate searches to be performed. Examiner Marschel disagreed, indicating that a number of differences between, for example, features of claims 1 and 23 require that each group be searched separately. No agreement has been reached in the interview.

The Office Action requires restriction to the following four groups of claims:

- I. Claims 1-22, 28-34, 44, 46, 51, 53, 54, 58, 60, and 61.
- II. Claims 23-27, 45, 52, and 59.
- III. Claims 35-38, 48, 49, 55, 56, 62, and 63.
- IV. Claims 39-43, 50, 57, and 64.


It is noted that claim 47 has been omitted from the listing of the claim in the above four groups. It is believed that claim 47 should be grouped together within the group I of claims. This response assumes that claim 47 should be in group I.

Group I containing claims 1-22, 28-34, 44, 46, 47, 51, 53, 54, 58, 60, and 61 is hereby elected for prosecution in the present application.

The Office Action further requires election between species A and B and between species C and D. We hereby elect species A. The claims that are readable on species A include claims 1-30, 33, 35-46, 48-53, 55-60 and 62-64. We also hereby elect species C. The claims that are readable on species C include claims 1-50 and 58-64.

The above elections are made without traverse.

Respectfully submitted,



James S. Hsue
Reg. No. 29,545